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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/631,967	08/01/2003	Alexander Hillisch	GULDE-0002	2520				
<div>23599      7590      07/17/2007</div> <div>MILLEN, WHITE, ZELANO &amp; BRANIGAN, P.C.</div> <div>2200 CLARENDON BLVD.</div> <div>SUITE 1400</div> <div>ARLINGTON, VA 22201</div>								
<div>EXAMINER</div> <div>BADIO, BARBARA P</div>								
<table border="1"><thead><tr><th>ART UNIT</th><th>PAPER NUMBER</th></tr></thead><tbody><tr><td>1617</td><td></td></tr></tbody></table>					ART UNIT	PAPER NUMBER	1617	
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<table border="1"><thead><tr><th>MAIL DATE</th><th>DELIVERY MODE</th></tr></thead><tbody><tr><td>07/17/2007</td><td>PAPER</td></tr></tbody></table>					MAIL DATE	DELIVERY MODE	07/17/2007	PAPER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/631,967

**Applicant(s)**

HILLISCH ET AL.

**Examiner**

Barbara P. Badio, Ph.D.

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-7,13 and 17-22 is/are allowed.
- 6) ☒ Claim(s) 3,8-12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**Final Office Action on the Merits of a RCE**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

2. The rejection of claims 4, 9-12 and 14-16 under 35 USC 112, second paragraph is withdrawn.
3. The rejection of claim 3 under 35 USC 112, second paragraph is maintained.

Applicant states that the superfluous text in the instant claim has been removed. Applicant's statement is noted. However, the removal of said does not over the rejection as stated in the previous Office Action. As stated, the instant claim recites, "Y **can be** a halogen atom". The phrase "can be" implies Y might not be a halogen atom. Again, the examiner suggests that "can be" be rewritten as "is" or "stands for".

For this reason, the rejection of claim 3 under 35 USC 112, second paragraph is maintained.

***Claim Rejections - 35 USC § 103***

4. The rejection of claims 8-12 and 14-16 under 35 USC 103(a) over Schubert et al. (US 5,693,628) is maintained.

Applicant's argument is that the references (Schubert and the secondary references) cited in the previous Office Action disclose "antigestigens" and not "androgenic action" as taught by the present invention. According to applicant said finding of "androgenic action" of the claimed compounds and their use as recited by the instant claims would be surprising to the skilled artisan. Applicant's argument was considered but not persuasive for the following reason.

There is no requirement that the prior art must suggest that the compound(s) will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. *In re Dillon*, 919 F.2d 688, 696, 16 USPQ 2d 1897, 1904 (Fed. Cir. 1990). An obviousness rejection is proper as long as the prior art suggests a reason or provides a motivation to make the claimed invention.

Schubert teaches the claimed compounds are useful antigestagenic agents. The art teaches the use of antigestagenic compounds in treating the claimed conditions. Therefore, the utilization of the compounds of Schubert in the treatment of the claimed conditions would have been obvious to the skilled artisan in the art at the time of the present invention. The motivation is based on the teachings of the prior art and the level of skill of the ordinary artisan in the art as demonstrated by the cited references.

For this reason and those given in the previous Office Action, the rejection of claims 8-12 and 14-16 under 35 USC 103(a) over Schubert et al. (US 5,693,628) is maintained.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

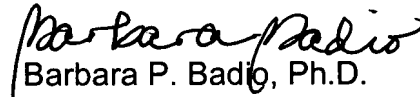
***Telephone Inquiry***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Barbara P. Badgley, Ph.D.  
Primary Examiner  
Art Unit 1617

BB  
July 12, 2007